

Application Serial No.: 09/877,926

Attorney Docket No. 019213-0311368

In Response to Office Action mailed January 30, 2006

REMARKS

In response to the Final Office Action mailed January 30, 2006 (hereinafter "Office Action"), claim 1 has amended to correct a typographical error. No claims are cancelled or newly added. Thus, no new matter has been added and claims 1-59 remain pending. In view of the foregoing amendment and following comments, reconsideration and allowance of all the claims pending in the application is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Examiner has rejected claims 1-59 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. *See* Office Action at 2-3. Applicant traverses this rejection for at least the reason that the claims meet the requirements of clarity and precision required by § 112, second paragraph.

The Examiner identifies several claim terms as allegedly failing to provide "clear definition of the meets [sic] and bounds of the term." *See* Office Action at 2. In particular, the Examiner objects to numerous claim terms, including "collaborate," "enabling," "to interact," and "forum" in the independent claims. The Examiner also alleges that the language in certain dependent claims, including "events," "actions," "client" and "participant," and "library of resources" are unclear, while also alleging that claims 4 and 18 are "confusing as a whole because the interrelationships claimed are not clear."

The Examiner has failed to provide any explanation of why the claim terms remain indefinite, particularly when considered in light of the knowledge of a person having ordinary skill in the art and the extensive Specification. The MPEP sets forth the clarity and precision requirements of § 112, second paragraph, and the Examiner has disregarded the proper standards of claim interpretation during prosecution, while also appearing to actively ignore the Specification. In particular, the MPEP specifies at § 2173.02:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is **whether the claim meets threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available**. When the

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examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, **he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.** (emphasis added).

If the Examiner prefers alternative language to make a claim clearer, the MPEP provides a remedy for such a situation. In particular, if “the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.” MPEP § 2173.02 (emphasis in original). Applicants submit that because the Specification provides ample description of the allegedly indefinite claim language, “the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph.” *Id.* Therefore, this rejection is improper and should be withdrawn.

Although Applicant submits that the claims are sufficiently clear, particularly when read in light of the Specification, portions of the Specification describing the allegedly unclear claim terms are provided herein to demonstrate to the Examiner their meaning and expedite prosecution. The following recitations and citations to the Specification are exemplary only and should not be viewed as limiting. The term “collaborate” is well understood to those skilled in the art, in addition to being used in the Specification. For example, the Specification indicates, among other things, that a team of financial advisors can “collaborate” with a common client to provide financial advice. This is provided, for example, by a common tool enabling participants to interact and share information with a client. *See, e.g.*, Specification at 4-5, 15. All of the allegedly indefinite claim terms are similarly described, i.e., “forum” (Specification at 4-5, 12), “enabling” (Specification at 12, 16), “to interact” (Specification at 5), “events” (Specification at 17), “actions” (Specification at 17-18), “clients” and “participants” (Specification at 4-5, 13-14), and “library of resources” (Specification at 68-70).

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The Examiner also continues to reject claims 28-54, alleging that a “system” is vague because it may fall into different statutory categories of invention. Applicant submits that the term “system” is sufficiently clear and is routinely used in patent claims without rejection. The rejection is without proper basis and is legally improper. No supporting rationale has been provided as to how a system may be interpreted to span multiple statutory categories, nor has Examiner responded to previous arguments challenging the basis of this rejection.

Finally, the Examiner has responded to Applicant’s previous arguments relating to the § 112, second paragraph rejections by indicating that “the terms are yet to be defined by applicant’s arguments.” *See* Office Action at 7. As discussed above, Applicant’s arguments are not the locus for providing the definition of claim terms, but rather the claim terms “must be given their broadest reasonable interpretation consistent with the specification.” *See* MPEP § 2111. Because Applicant has identified specific portions of the Specification discussing the challenged claim terms, the Examiner is respectfully requested to fully consider the teachings of the Specification when responding to Applicant’s arguments. For at least the foregoing reasons, the rejections under 35 U.S.C. §112, second paragraph are improper and should be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-5, 7-19, 22-32, 34-46, 49-54, and 57-58 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,940,843 to Zucknovich *et al.* (“Zucknovich”). *See* Office Action at 3-4. Claims 6, 20-21, 33, and 47-48 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich further in view of U.S. Patent No. 6,430,542 to Moran. *See* Office Action at 4-5. Claims 55 and 56 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich further in view of U.S. Patent No. 5,787,175 to Carter. *See* Office Action at 5. Claim 59 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich further in view of U.S. Patent No. 6,243,722 to Day *et al.* (“Day”). *See* Office Action at 5-6.

Applicant traverses these rejections for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness. Because Zucknovich fails to teach or suggest several

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claimed features, in addition to being nonanalogous art, the rejection is improper and should be withdrawn.

Referring to claim 1, Zucknovich fails to teach or suggest “providing a common electronic forum containing client data wherein client data is accessible by one or more financial service provider participants wherein each participant has predefined authorizations.” The Examiner identifies col. 5, lines 60-67 of Zucknovich, describing research contributors and research contributor reports, as allegedly teaching the claimed “client” and “client data,” respectively. Additionally, the Examiner identifies col. 6, lines 25-30 of Zucknovich, describing distribution of reports to investors, as teaching the claimed “participant...predefined authorizations.” Applicant respectfully disagrees with the Examiner’s position for several reasons.

Zucknovich does not teach or suggest “a common electronic forum containing client data” for at least the reason that nothing within the disclosure of Zucknovich could reasonably be considered the claimed “client data.” In the claimed invention, collaboration between clients and participants is enabled by granting participants authorization to “client data.” That is, the data in question is specific to the client, and participants may be authorized to access the client data. Even assuming *arguendo* that the research contributors and investors of Zucknovich are analogous to the claimed “clients” and “participants,” the research contributors are delivering research regarding third-parties to investors. Therefore, the research reports cannot reasonably be considered the claimed “client data” because the reports contain content that describe neither the research contributors nor the recipients of the report. The Examiner’s attention is directed to the Background section of Zucknovich, which describes the operation of third party financial research firms. Because research firms are entities that deliver information regarding public companies to investors, the content of the research pertains to third-party companies rather than the research firm itself, and therefore cannot be equated to the claimed “client data” in the manner alleged by the Examiner.

Zucknovich also fails to teach or suggest the claimed feature of “enabling the financial services client to interact with one or more financial service providers through the common electronic forum.” The Examiner alleges that Zucknovich teaches this feature at col. 8, lines 14-

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50, which generally describes an investor logging into a web site to download research reports. See Office Action at 4. Applicant respectfully disagrees with the Examiner's assessment, for at least the reason that there is no interaction between the parties described in Zucknovich. The disclosure of Zucknovich relates to research contributors independently completing research reports and submitting the reports to a central repository (col. 5, lines 59-65; col. 6, lines 17-39; col. 6, lines 60-67). Once the research report has been stored on the central repository, the contributors role in the process is complete. Investors later log in to the web site and may download the report if their access is not restricted (col. 7, lines 48-61; col. 8, lines 15-62). There is no communication or "interaction" between the investors and contributors, whereas the claimed invention requires "enabling the financial services client to interact with one or more financial service provider participants through the common electronic forum." Because Zucknovich fails to teach or suggest at least this feature of the claimed invention, the rejection is improper and should be withdrawn.

In addition to failing to teach or suggest several claim features, the rejection is improper because Zucknovich is directed to nonanalogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a). As discussed above, Zucknovich's field of endeavor is distribution of research reports from research providers to investors. The content of the research has no relationship to the recipients, the research is accessible by many different parties, and the research relates to third-parties. In addition, the problem addressed by Zucknovich is compliance with Securities and Exchange Commission (SEC) laws (col. 1 lines 45-57). In contrast, Applicant's field of endeavor and problem addressed is providing collaboration between clients and financial service providers. The collaboration enables financial service providers and clients to work together to meet the needs of the client. These are clearly distinct fields of endeavor and distinct problems, for at least the reason that distribution and regulation of access to third-party research in accordance with SEC requirements is unrelated to financial service providers collaborating with a client to provide financial advice and services.

In response to Applicant's previous arguments that Zucknovich was nonanalogous art, the

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Examiner alleged that Zucknovich was analogous because Zucknovich allegedly is “capable of performing the function of the instant application.” See Office Action at 8. This is not the correct legal test for analogous art. Applicant has previously submitted that a reference is not analogous simply because it is capable of performing the function of the instant application. The relevant test for determining whether or not a reference is analogous is discussed above, and relates specifically to the field of endeavor and problems addressed by the invention. Even if being “capable of performing the function” were the test, it is not clear that such an assertion is true here. Regardless, since Zucknovich does not qualify as analogous art, each of the rejections based thereon must fail. The Examiner has also failed to establish that any of the other references relied upon qualify as analogous art. Applicant further maintains that the Examiner has failed to address these points, which have been raised in the prior response, and respectfully requests the Examiner consider the field of endeavor and problems addressed when responding to Applicant’s arguments.

Finally, the Examiner’s allegation that Zucknovich in view of Moran is admitted art is traversed. Applicants have previously maintained that no such admission was made, as the deficiencies discussed regarding the rejections of the independent claims carries into the discussion of the dependent claims. The response filed on April 25, 2005 focused on the deficiencies of the base reference, Zucknovich, and clearly recited that “[n]one of the prior art *relied on* shows the features claimed...” See 4/25/05 Amendment at pg. 14 (emphasis added). Applicant notes that there are numerous bases upon which to attack the alleged combinations of the secondary references with Zucknovich. While Applicant expressly reserves the right to present such arguments at a future time, it is not necessary to do so at this time as the secondary references fail to cure the deficiencies of the primary reference (Zucknovich) articulated above, even assuming *arguendo* that the references could even be properly combined.

For at least the foregoing reasons, the rejection of claim 1 is improper and must be withdrawn. Independent claims 15, 28, 42, and 57 contain similar features as those discussed for claim 1, and the rejections of these claims are likewise improper for at least the reasons discussed for claim 1. Dependent claims 2-14, 16-27, 29-41, 43-56, and 58-59 depend from and

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add features to one of independent claims 15, 28, 42, and 57, and therefore the rejections of these claims are likewise improper for at least the same reasons.

NON-STATUTORY DOUBLE PATENTING REJECTION

Claims 1-59 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-37 of co-pending Application No. 09/732,008. *See* Office Action at 9.

The rejection for double patenting is believed to be premature as no claims have been allowed. In the event necessary, upon the indication of allowable subject matter, Applicant will consider filing a Terminal Disclaimer.

Amendment dated: July 26, 2006

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CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: July 26, 2006

Respectfully submitted,

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